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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,672

01/25/2002

Richard W. Berenson

T00485/70004 INB

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04/21/2006

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EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 04/21/2006 .

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,672

Applicant(s)

BERENSON ET AL.

Examiner

Justin E. Shepard

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14, 16, 18 and 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 11-13, 15, 17 and 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14, 16, 18 and 23-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species: figures 1 and 4. The species are independent or distinct because the figures indicate two different methods of transmitting data to the user.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.
MPEP § 809.02(a).

During a telephone conversation with Ilan Barzilay on 4/5/2006 a provisional election was made without traverse to prosecute the invention of figure 1, claims 1-10, 14, 16, 18, and 23-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-13, 15, 17, and 19-22 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-10, 14, 16, 23-25, 27-33, 35, 36, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn.

Referring to claim 1, Kahn discloses a system for recording purchased programming (column 3, lines 37-41), the system comprising: a device by which a user places an order for purchased programming (column 7, lines 58-62); and a recording device controller connected through at least one communication medium to a recording device (figure 5A, part 528; figure 5B, part 406), the recording device controller verifying

that the recording device is programmed to record the purchased programming and the recording device controller canceling the order if it is not verified that the recording device is programmed to record the programming (column 7, lines 62-67; Note: confirming the right to purchase is interpreted as being equivalent to canceling the order when the device is not verified).

Referring to claim 2, Kahn discloses a system of claim 1, wherein the recording device is a digital video recorder (column 3, lines 37-41).

Referring to claim 3, Kahn discloses a system of claim 1, wherein the at least one communication medium is a different medium than a transmit medium used to deliver the purchased programming (figure 1).

Referring to claim 4, Kahn discloses a system of claim 1, further comprising a device, which sends the order to a distributor of the purchased programming (column 7, lines 58-62).

Referring to claim 5, Kahn discloses a system of claim 1, wherein the recording device controller sends the order to a distributor of purchased programming (figure 5B, part 540).

Referring to claim 6, Kahn discloses a system of claim 1, wherein the recording device controller instructs the recording device to record the purchased programming (column 10, lines 27-30).

Referring to claim 8, Kahn discloses a system of claim 1, wherein the recording device cannot transfer the purchased programming to any other device (column 11, lines 60-61).

Referring to claim 9, Kahn discloses a system for the delivery of programming, the system comprising: an order processor; a program source device (figure 1; column 4, lines 51-55); and a user recording device (figure 5A, part 528); the order processor executing instructions to: receive from a user and process an order for a program (column 7, lines 58-62), communicate commands with the user recording device, communicate commands with the program server (column 7, lines 62-67), and store user data (column 12, lines 12-16); the program source device executing instructions to: communicate commands with the order processor (column 7, lines 58-62), send a program to the user recording device, and authorize the receiving of the program by the user recording device (column 7, lines 62-67); and the user recording device executing instructions to: communicate commands with the order processor (column 7, lines 58-62), receive the program from the program service device, and record the program (column 10, lines 48-51).

Referring to claim 10, Kahn discloses a system of claim 9, the user recording device further executing instructions to confirm its ability to receive and/or record the program (column 7, lines 62-67).

Referring to claim 14, Kahn discloses instructing the user recording device to record the program (column 10, lines 27-30 and 48-51). The remaining limitations have been addressed in the rejection of claim 9.

Referring to claim 16, Kahn discloses a system for the delivery of programming, the system comprising: a user recording device executing instructions to: communicate commands a program controller (column 7, lines 58-62), receive a program from a program service device (column 10, lines 48-51), and record the program pursuant to a command from the program controller (column 10, lines 27-30).

Referring to claim 23, Kahn discloses a system for recording purchased programming, the system comprising: a recording device that performs actions comprising: receiving purchased programming (column 10, lines 48-51), recording purchased programming (column 10, lines 48-51), and communicating instructions with a programming delivery mechanism (column 7, lines 58-62); and the programming delivery mechanism that performs actions comprising: receiving at least one order for purchased programming (column 7, lines 58-62), sending purchased programming (column 10, lines 48-51), communicating instructions with the recording device (column

10, lines 27-30), and instructing the recording device to record the purchased programming (column 10, lines 48-51).

Referring to claim 24, Kahn discloses a system of claim 23, wherein the actions performed by the programming delivery mechanism further comprise encoding the purchased programming (figure 2, part 202A).

Referring to claim 25, Kahn discloses a system of claim 23 or 24, wherein the actions performed by the recording device further comprise decoding the purchased programming (figure 4, part 416).

Referring to claim 27, Kahn discloses a system for recording purchased programming, the system comprising: a programming delivery mechanism that performs actions comprising: receiving an order for purchased programming (column 7, lines 58-62); communicating instructions with a recording device (column 10, lines 27-30); instructing the recording device to record the purchased programming (column 10, lines 48-51); and verifying that the recording device is programmed to record the purchased programming (column 10, lines 27-30).

Referring to claim 28, Kahn discloses a system of claim 27, wherein the actions performed by the programming delivery mechanism further comprise: if the recording device is not programmed to record the purchased programming perform one or more

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of the following actions: cancel the order (column 7, lines 62-67; Note: see rejection of claim 1); send a notification that the order was cancelled; reschedule the order; and instruct the recording device to record the purchased programming according to the rescheduled order.

Claim 35 is rejected on the same grounds as claim 28.

Referring to claim 29, Kahn discloses a system of claim 27 or 28, wherein the actions performed by the programming delivery mechanism further comprise sending the purchased programming to the recording device (figure 5A parts 512, 514, and 528).

Referring to claim 30, Kahn discloses a system of claim 29, wherein the actions performed by the programming delivery mechanism further comprise encoding the purchased programming (figure 2, part 202A).

Referring to claim 31, Kahn discloses a system for recording purchased programming, the system comprising: a recording device that performs actions comprising: receiving purchased programming (column 10, lines 48-51); recording the purchased programming (column 10, lines 48-51); communicating instructions with a programming delivery mechanism (column 7, lines 58-62); and verifying to the programming delivery mechanism that the recording device is programmed to record a particular purchased program (column 7, lines 62-67).

Referring to claim 32, Kahn discloses a system of claim 31, wherein the actions performed by the recording device further comprise displaying the particular purchased program (figure 5A, part 530).

Referring to claim 33, Kahn discloses a system of claim 31, wherein the actions performed by the recording device further comprise decoding the purchased programming (figure 4, part 416).

Referring to claim 36, Kahn discloses a method of claim 35, wherein the recording device is a digital video recorder (column 3, lines 37-41).

Referring to claim 38, Kahn discloses a method of claim 35, further comprising sending the order to a distributor of the purchased programming (column 7, lines 58-62).

Referring to claim 39, Kahn discloses a method of claim 35, further comprising instructing the recording device to record the purchased programming (column 10, lines 27-30).

Referring to claim 40, Kahn discloses a method of claim 35, wherein the verifying includes determining that the recording device cannot transfer the program to any other device (column 11, lines 60-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Towell.

Referring to claim 7, Kahn does not disclose a system of claim 1, wherein the recording device controller notifies the user of a status of the order.

Towell discloses a system of claim 1, wherein the recording device controller notifies the user of a status of the order (column 4, lines 29-30).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the notification taught by Towell to the system disclosed by Kahn. The motivation would have been indicate to the user a problem has occurred so that they would be able to fix what is causing the issue.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Novak.

Referring to claim 18, Kahn does not disclose a system of claim 16, wherein the program is received from the program service device along the same medium as the commands are communicated with the program controller.

Novak discloses a system of claim 16, wherein the program is received from the program service device along the same medium as the commands are communicated with the program controller (page 3, column 1, lines 2-5).

At the time of the invention it would have been obvious for one of ordinary skill in the art to transmit the upstream and downstream data over the same medium as taught by Novak in the system disclosed by Kahn. The motivation would have been to enable higher speed transfers in the upstream communication by transmitting the commands by satellite.

Claims 26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Rosengren.

Referring to claim 26, Kahn does not disclose a system of claim 23 or 24, further comprising: a decoding device that performs actions comprising: decoding the purchased programming; and sending the decoded purchased programming to the recording device.

Rosengren discloses a system of claim 23 or 24, further comprising: a decoding device that performs actions comprising: decoding the purchased programming; and sending the decoded purchased programming to the recording device (figure 8A, part 82; column 2, lines 53-54).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the transcoder (combination decoder/encoder) taught by Rosengren to the system disclosed by Kahn. The motivation would have been to enable the system to record the feed at a lower quality to save space on the recording device (Rosengren: column 2, lines 7-9)

Referring to claim 34, Kahn does not disclose a system of claims 31, 32 or 33, wherein the actions performed by the recording device further comprise encoding the particular purchased program.

Rosengren discloses a system of claims 31, 32 or 33, wherein the actions performed by the recording device further comprise encoding the particular purchased program (figure 8A, part 82; column 2, lines 53-54).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the transcoder (combination decoder/encoder) taught by Rosengren to

the system disclosed by Kahn. The motivation would have been to enable the system to record the feed at a lower quality to save space on the recording device (Rosengren: column 2, lines 7-9)

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Nations.

Referring to claim 37, Kahn does not disclose a method of claim 35, wherein the order is placed over the Internet.

Nations discloses a method of claim 35, wherein the order is placed over the Internet (column 7, lines 9-13).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the internet application to order movies, as taught by Nations, in the system disclosed by Kahn. The motivation would have been to use an existing protocol such, as an Internet protocol, to transmit the requests to enable the set top box to use off the shelf components.

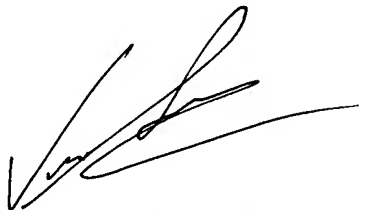
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



VIVEK SRIVASTAVA
PRIMARY EXAMINER